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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,574	02/05/2001	Takashi Takenaga	P107156-00047	9571

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EXAMINER

DURAN, ARTHUR D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/775,574

Applicant(s)

TAKENAGA, TAKASHI

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-3 have been examined.

#### ***Response to Amendment***

2. The Amendment filed on 7/26/04 is insufficient to overcome the DeLorme reference.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by DeLorme (5,948,040).

DeLorme is considered to disclose the claimed system comprising:

an advertisement site for displaying the advertisements the map image displayed on said user terminal, including a advertisement server for displaying route setting and advertisements situated along the set route on the map image, a route database storing road data on a map required for setting server, advertisement data (column 14 lines 1-42),

wherein said advertisement server sets a route based on the road data stored said route database, and read out advertisements situated along the set route from said a route in said advertisement database storing registered advertisement database to display them on the user

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terminal (column 14 lines 53-65). DeLorme is considered to also disclose the claimed user profile matching (column 16 lines 60-65) and user registration (column 31 lines 52-67).

Additionally, De Lorme discloses a map with points of interest (Fig 1a, item 109); a map and route with advertisements along the route (Fig. 1b-3; Fig. 5; Fig. 5d ) a database connecting places and routes (Fig. 3, Geographic Data) that geographic points of interest and advertisements can be displayed along with the map or route setting (col 1, lines 35-46; col 1, line 57-col 2, line 2; col 6, lines 37-41; col 13, lines 5-10; col 47, lines 45-60).

De Lorme further discloses the use of a server (col 10, lines 10-17; col 14, line 65-col 15, line 15).

De Lorme further discloses that the information provided via TRIPS can be paid for by third-party providers of goods or services (col 30, lines 25-32) and that third-parties can offer special offers for goods and services available through TRIPS (col 6, lines 31-37). Hence, the information provided by TRIPS is functionally equivalent to advertisements.

De Lorme further discloses providing relevant advertisements along with the map (col 35, lines 49-56).

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-3 have been considered but are not found persuasive.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

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Please also note that the additional citations added below have also been added to the rejection above.

On page 2 of the Applicant's Amendment dated 7/26/04, Applicant states, "DeLorme . . . fails to teach . . . an advertisement server for displaying a route setting and advertisements situated along the set route on the map image".

However, De Lorme discloses a map with points of interest (Fig 1a, item 109); a map and route with advertisements along the route (Fig. 1b-3; Fig. 5; Fig. 5d ) a database connecting places and routes (Fig. 3, Geographic Data) that geographic points of interest and advertisements can be displayed along with the map or route setting (col 1, lines 35-46; col 1, line 57-col 2, line 2; col 6, lines 37-41; col 13, lines 5-10; col 47, lines 45-60).

De Lorme further discloses the use of a server (col 10, lines 10-17; col 14, line 65-col 15, line 15).

De Lorme further discloses that the information provided via TRIPS can be paid for by third-party providers of goods or services (col 30, lines 25-32) and that third-parties can offer special offers for goods and services available through TRIPS (col 6, lines 31-37). Hence, the information provided by TRIPS is functionally equivalent to advertisements.

De Lorme further discloses providing relevant advertisements along with the map (col 35, lines 49-56).

Additionally, the online Merriam-Webster dictionary defines 'advertisement' as,  
"1 : the act or process of advertising  
2 : a public notice; *especially* : one published in the press or broadcast over the air"  
, and 'advertising' as,

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“1 : to make something known to : NOTIFY

2 a : to make publicly and generally known <advertising their readiness to make concessions> b

: to announce publicly especially by a printed notice or a broadcast c : to call public attention to especially by emphasizing desirable qualities so as to arouse a desire to buy or patronize :

PROMOTE *intransitive senses* : to issue or sponsor advertising”.

Hence, De Lorme discloses all the features of the Applicant's claimed invention.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

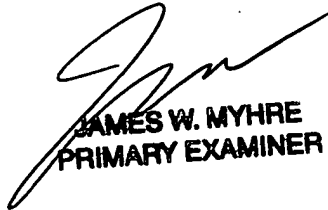
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AW

10/21/04

  
JAMES W. MYHRE  
PRIMARY EXAMINER